

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Peter Charles SUMMERSELL

Art Unit: 3731

Application No.: 10/031,453

Confirmation No.: 6926

Examiner: M. Thaler

Filing Date: February 1, 2001

Washington, D.C.

371(c) Date: May 29, 2002

Atty.'s Docket: SUMMERSELL =1

For: SURGICAL DEVICE

Date: April 6, 2005

U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building, Mail Stop AMENDMENT  
401 Dulany Street  
Alexandria, VA 22314



Sir:

Transmitted herewith is a [XX] REPLY TO RESTRICTION REQUIREMENT in the above-identified application.

[XX] Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted

[ ] A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.

[XX] No additional fee is required.

The fee has been calculated as shown below:

(Col. 1)		(Col. 2)		(Col. 3)	SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS	RATE	ADDITIONAL FEE		RATE	ADDITIONAL FEE
TOTAL	*	MINUS	** 20	0	x 25	\$		x 50	\$
INDEP.	*	MINUS	*** 3	0	x 100	\$		x 200	\$
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+ 180	\$		+ 360	\$
					ADDITIONAL FEE TOTAL			TOTAL	

\* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

\*\* If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

\*\*\* If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[XX] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

[ ] First - \$ 60.00  
[ ] Second - \$ 225.00  
[ ] Third - \$ 510.00  
[ ] Fourth - \$ 795.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

[ ] First - \$ 120.00  
[ ] Second - \$ 450.00  
[ ] Third - \$ 1020.00  
[ ] Fourth - \$ 1,590.00

Month After Time Period Set

[ ] Less fees (\$ ) already paid for month(s) extension of time on .

[ ] Please charge my Deposit Account No. 02-4035 in the amount of \$ .

[ ] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$ .

[ ] A check in the amount of \$ is attached (check no. ).

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: SUMMERSELL=1

In re Application of:	)	Confirmation No.: 6926
	)	
Peter Charles SUMMERSELL	)	
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Appln. No.: 10/031,453	)	Art Unit: 3731
	)	
Filing Date: February 1, 2001	)	Examiner: M. Thaler
371(c) Date: May 29, 2002	)	
	)	
For: SURGICAL DEVICE	)	April 6, 2005

**REPLY TO RESTRICTION REQUIREMENT**

Honorable Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building, Mail Stop Amendment  
401 Dulany Street  
Alexandria, VA 22314

Sir:

Applicant is in receipt of an Office Action mailed March 8, 2005, primarily in the nature of a requirement for restriction.

Acknowledgment by the PTO of the receipt of applicant's papers filed under §119 is noted.

Restriction has been required between what the PTO deems to be two (2) patentably distinct inventions. As applicant must make an election even though the requirement is traversed, applicant hereby provisionally and respectfully elects Group I directed to a cannula and assembly, and

presently comprising claims 1-24, with traverse and without prejudice.

The examiner recognizes that the present application is the U.S. national phase of an International (PCT) application, whereby normal U.S. restriction practice does not apply. Instead of restriction practice, the appropriate practice is "unity-of-invention" practice per PCT Rules 13.1 and 13.2. In this regard the PTO takes the position that there is no unity-of-invention because there is no same or corresponding technical feature under PCT Rule 13.2. However, the reasons given are not reasons which have anything to do with a single general inventive concept or the same or corresponding special technical feature, but instead the reason given by the PTO is a U.S. restriction practice reason which does not apply in the present case.

Original main claims 1 and 25 are still pending, and these are the two claims which must be evaluated for compliance with unity-of-invention under PCT Rules 13.1 and 13.2. In this regard, please note line 3 of claim 25 which defines the cannula which is used in the method of claim 25 as being the cannula of claim 1. Thus, the claims of Groups I and II share the same or corresponding special technical features, namely the features recited in claim 1.

As confirmation that applicant's position is correct as explained above, attention is respectfully invited to the

International Preliminary Examination Report (IPER), form PCT/IPEA/409 (cover sheet), section 3, part IV, which shows that during the international stage there was no finding of lack of unity-of-invention. Of course, applicant understands that the PTO is not bound by the International Preliminary Examination Report, but on the other hand such IPER is correct and should not be brushed aside, particularly in view of the principles of harmonization and comity.

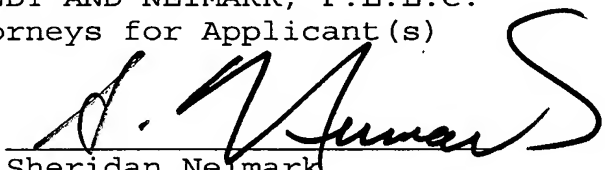
Respectfully, unless and until the PTO is able to find prior art which establishes that the two Groups lack the same or corresponding special technical feature, and no such prior art is known to applicant, it must follow that there is unity-of-invention, whereby the restriction requirement should be withdrawn and all the claims examined on the merits.

Accordingly, applicant respectfully requests favorable reconsideration, withdrawal of the requirement, and examination of all the claims on the merits.

Respectfully submitted,

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